

The newly cited Hamel reference is discussed below in section B and in the Affidavits of Drs. Bowman and Morand attached hereto.

A. NEITHER BLAKE ET AL. NOR CANGUILHEM TEACH OR SUGGEST THE CLAIMED SCORING, SUMMING AND PLOTTING STEPS

Applicant's claimed invention is a *quantitative* system which uses actual metrics for analyzing a specific asset by collecting and summing score data and calculating and plotting a position on a chart in accordance with the scores. Independent claim 1 of the present application recites, *inter alia*, the steps of:

scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest;

storing said plurality of scores obtained by said scoring step in an electronic database;

using a computing apparatus to read and sum said stored plurality of scores to generate first and second total scores based upon the extent to which individual statements accurately describe said intangible asset of interest;

using a printer to transform physical media into a chart by physically plotting on said media a first axis relating to said first variable and a second axis relating to said second variable;

using said printer to physically plot a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively;

The Examiner asserts that Blake et al. disclose two variables, criteria statements, first and second scores, a chart with two axes each relating to one of the variables, and plotting a

point on the chart corresponding to the first and second total scores. Applicant respectfully disagrees for the reasons set forth below.

Blake et al. merely disclose a chart which is intended to express the differences between several managerial styles. Blake et al. fail to teach or suggest the recited step of scoring performance criteria statements, fail to teach or suggest the recited step of summing a plurality of scores obtained by that scoring step, and fail to teach or suggest physically plotting a point on a chart at a location corresponding to first and second total scores. The numbers used on the two axes are not scores at all, and are certainly not sums of performance criteria statement scores. The 9,9, 9,1, 1,9, 5,5, and 1,1 values on Figure 1 of Blake et al. are used only to identify portions of the grid. These values are not used for calculating chart positions; Blake et al. could equally well have used words alone to define the five management styles.

The significance of the numbering scheme shown on Figure 1 of Blake et al. can be seen clearly from Chapter 3 thereof, a copy of which was attached to Applicant's response filed October 2, 2001. For example, in Chapter 3, Blake et al. describe the characteristics of the 9,1 Management Style in words, describing how the following issues are handled in this management approach: the concept of goals, boss-subordinate relationships, creating and maintaining morale, communication activities, approaches to managing conflict, impact on creativity and change, commitment, management development, personal behavior. There is no teaching or suggestion of performing any calculations in this respect; there are only descriptions of the behavior related to "9,1 Management." Chapters 4, 5, 6 and 7 repeat the above analysis for each of the other four grid positions. There is likewise no disclosure in those chapters of calculations to generate particular chart positions.

The numbers associated with the axes in the cited portion of Blake et al. are merely used as labels for each management style; the actual values of these numbers are superfluous to Blake's disclosure, which relates to the distinctions between different management styles. The inclusion of these axis labels does not teach or suggest the presently claimed quantitative process for producing a chart, which includes the steps of scoring performance criteria statements, summing scores, and physically plotting a point on the chart corresponding to first and second scores.

The Examiner recognizes that Blake et al. do not teach the use of the chart produced in accordance with the steps discussed above in making at least one decision regarding the value of an intangible asset of interest. While the Examiner argues that this would have been obvious to one skilled in the art in view of Canguilhem, Applicant respectfully disagrees. As set forth above, Blake et al. disclose a chart for aiding in the understanding of different managerial styles, and do not teach or suggest the claimed steps for calculating a numerical value for a particular intangible asset of interest in order to analyze that intangible asset. Thus, it is respectfully submitted that Blake et al., even when combined with Canguilhem, would not suggest the claimed step of using the chart produced in accordance with the steps discussed above in making at least one decision regarding the value of an intangible asset of interest.

Blake et al. and Canguilhem fail to teach or suggest at least the claimed steps of scoring performance criteria statements, summing scores, physically plotting a point on a chart corresponding to first and second scores, and using the chart thus produced in making at least one decision regarding the value of an intangible asset of interest. It is well-established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. In Re Boyka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (C.C.P.A. 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (C.C.P.A. 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (C.C.P.A. 1973).

B. NEITHER HAMEL, BLAKE ET AL. NOR CANGUILHEM TEACH OR SUGGEST INDEPENDENT VARIABLES OR THE CLAIMED SCORING STEP, AND THE CLAIMED INVENTION IS NONOBVIOUS THEREOVER.

Independent claim 1 of the present application recites, *inter alia*, the following:

...establishing a first independent variable and a second independent variable related to the value of said specific intangible asset of interest...

...scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest;

As is recognized by the Examiner, neither Blake et al. nor Canguilhem teach or suggest establishing a first independent variable and a second independent variable related to a specific intangible asset of interest. With respect to Blake et al., and with respect to the Examiner's use of Blake et al. in the pending § 103 rejections, Applicant specifically incorporates herein each of the arguments set forth in Applicant's Response filed October 2, 2001. With respect to Canguilhem, Applicant refers the Examiner to the discussion thereof in the attached affidavits of Drs. Bowman and Morand.

With respect to the newly cited Hamel reference, the cited Figs. 7.2, 7.3, and Chapter 7, teach a non-quantitative method wherein evaluators create and label grid positions based on conjectural "low" and "high" values. In Chapter 8, Hamel makes use of a five-point qualitative scale to better represent the space between low and high values and to help a company to assess where its skill sets can be used to advantage.

The claimed invention, unlike Hamel (and unlike Blake et al. and Canguilhem), determines the value of an intangible by, *inter alia*, scoring each of a plurality of performance criteria statements that are probative of independent variables to produce a plurality of scores which reflect the applicability of the performance criteria statements to the intangible, and then summing the scores to generate first and second total scores. Grid positions are not created and labeled based simply upon conjectural high and low values, but rather the positions reflect a sum of performance criteria scores which are distinct from (or "external to") the independent variables. Neither Hamel nor Blake et al. nor Canguilhem teach or suggest establishing a first independent variable and a second independent variable related to the value of said specific intangible asset of interest, or scoring each of a plurality of performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to the specific intangible asset of interest.

Attached hereto as Exhibit 1 is the Declaration of Dr. John C. Bowman. Dr. Bowman further explains the disclosure of the Hamel ("Hamel and Hean") and Canguilhem references and testifies that (1) neither Canguilhem alone nor in combination with Blake and Hamel would enable a person of ordinary skill in the art to practice the presently claimed invention, and (2) neither Canguilhem alone nor in combination with Blake and Hamel would render the presently claimed invention obvious to a person of ordinary skill in the art.

Attached hereto as Exhibit 2 is the Declaration of Dr. Peter Morand. Dr. Morand testifies that (1) the combination of the teachings of Canguilhem, Blake, and Hamel would not enable one of ordinary skill in the art to practice the presently claimed invention, and (2) the combination of the teachings of Canguilhem, Blake and Hamel would not render the presently claimed invention obvious to one of ordinary skill in the art.

Attached hereto as Exhibit 3 is the Declaration of J. Ronald McCullough. Dr. McCullough testifies that (1) the claimed invention has been commercially successful, and (2) the claimed invention has received extensive acclaim in the industry.

It is respectfully submitted that the three Declarations discussed above show secondary considerations of non-obviousness which are fully effective to overcome any showing of obviousness asserted by the Examiner with respect to the Blake, Canguilhem and Hamel references. See 37 C.F.R. § 1.132, MPEP § 716.

In view of all of the above, it is submitted that the rejection of claims 1-18 under 35 U.S.C. § 103(a) over Blake in view of Canguilhem and further in view of Hamel is improper and must be withdrawn.

C. TURNBULL FAILS TO TEACH OR SUGGEST CLAIMS 19-20

Dependent claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over The Managerial Grid in view of Canguilhem, further in view of Hamel, and yet further in view of Turnbull. All of the arguments set forth above and in Applicant's Response filed June 30, 2003 with respect to independent claim 1 are fully applicable to

dependent claims 19 and 20, and are incorporated herein. The disclosure of Turnbull, like that of Blake et al., is qualitative in nature. Applicant agrees with the Examiner's assertion that Turnbull suggests assessment by graphic representation of current and future positions of a company. Applicant further agrees with the Examiner that the last two paragraphs of page 12 of Turnbull disclose generating future business portfolios based on project trends of certain factors in order to identify major strategic issues facing the company. However, Applicant sees no teaching or suggestion in Turnbull of the recited steps of calculating the future value by:

iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level.

Turnbull clearly fails to teach or suggest the above-recited calculating steps, particularly in the cited pages 7 and 12. In order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. *In re Boyka, supra*. Turnbull describes a number of portfolio planning models that are used to describe the position of companies with respect to their business strengths and weakness, in particular those that are relevant to their competition. These models use graphic presentations to illustrate different current and future positions. The positions are established by arbitrary judgements and are not calculated. The BCG approach described by Turnbull on page 12, cited by the Examiner, uses a 10% growth rate to separate regions on the grid and then uses terms like Cash Cows to describe specific companies. One could equally have used the words "high" and "low" to separate these regions. This point is well illustrated on page 16 of Turnbull, where it is noted that:

The portfolio analysis is done by positioning each SBA in a scatter diagram along two dimensions; profitability and life cycle position. Profitability is on a five-

point scale; outstanding, high, average, low and loss. Life cycle on the horizontal axis is classified into four positions; emergence, growth, maturity and decline.

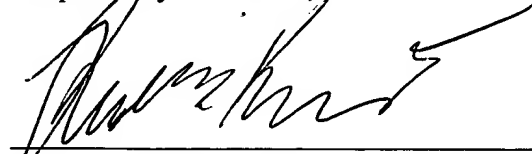
Turnbull's use of the word "classified" clearly indicates that the positions are judgments and not arrived by calculation. This is true for both the current positions and the desired future positions. Applicant's claimed quantitative steps, reproduced above, are not suggested.

Dependent claims 19 and 20 are, therefore, allowable over the cited art and the rejection under 35 U.S.C. § 103(a) over Blake in view of Canguilhem, further in view of Hamel, and further in view of Turnbull must be withdrawn.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that claims 1 thru 20 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,



Richard E. Kurtz, II (Reg. No. 33,936)
Attorney for Applicants

GREENBERG TRAURIG
1750 Tysons Boulevard, 12th Floor
McLean, VA 22102
(703) 749-1330
E-mail: kurtzr@gtlaw.com

Filed: February 3, 2004